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IN THE

Supreme Court of the United States

OCTOBER TERM, 1951.

No. 217

BENJAMIN STEIN, RENA STEIN, AND HENRY KUTNER, DOING BUSINESS AS REGLOR OF CALIFORNIA,
Petitioners,

vs.

EXPERT LAMP COMPANY, A CORPORATION,
Respondent.

PETITION FOR WRIT OF CERTIORARI.

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W. W. GLENNY.

July 30, 1951.

THE DUNTHORP-WARREN PRINTING COMPANY, 310 WEST JACKSON, CHICAGO

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vs.

EXPERT LAMP COMPANY, A CORPORATION,
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PETITION FOR WRIT OF CERTIORARI.

Petitioners, Benjamin Stein, Rena Stein, and Henry Kutner, doing business as Reglor of California, pray that a writ of certiorari issue to review the judgment of the Court of Appeals for the Seventh Circuit (R. 56-60) in the above-entitled cause, affirming the decision of the United States District Court for the Northern District of Illinois, Eastern Division (R. 41). A petition for rehearing was denied (R. 60).

Opinions Below.

The memorandum opinion of the District Court appears at page 41 of the record and the opinion of the Court of Appeals at page 56. The opinions are reported at 96 F. S. 97 and 188 F. (2d) 611, respectively.

Jurisdiction.

The jurisdiction of this Court is founded upon Title 28, Section 1254(1), United States Code. The judgment of the Court of Appeals, which Petitioners here seek reviewed, is dated May 22, 1951. This petition is filed before August 20, 1951, and is, therefore, timely.

Question Presented.

Is a copy of a copyrighted statuette, otherwise an infringement, outside the scope of the copyright because the copy is sold as part of a complete lamp, when the artistic features of the original statuette are in full view in the copy and are wholly unrelated to and unaffected by the functional purpose of the lamp?

In other words, can an infringement of a copyrighted work of art be made less so by adding utilitarian parts that do not alter the artistic impression?

Statutes Involved.

The questions here presented involve the construction of the Copyright Code, 17 U. S. C. 1 and 5 (g), which, in its relevant portions, reads:

> "§ 1. Exclusive Rights as to Copyrighted Works.—Any person entitled thereto, upon complying with the provisions of this title, shall have the exclusive right:
>
> (a) To * * * copy, and vend the copyrighted work;"
>
> * * * * *
>
> "§ 5. Classification of Works for Registration.—The application for registration shall specify to which

of the following classes the work in which copyright is claimed belongs:

* * * * *

(g) Works of art; models or designs for works of art."

This case also involves Regulation 202.8 of the Copyright Office, reading as follows:

"§ 202.8. Works of art (Class G)—(a) In General. This class includes works of artistic craftsmanship, in so far as their form but not their mechanical or utilitarian aspects are concerned, such as artistic jewelry, enamels, glassware, and tapestries, as well as all works belonging to the fine arts, such as paintings, drawings and sculpture. * * *"

Also involved in this case is the Design Patent Law, reading in part:

"Any person who has invented any new, original, and ornamental design for an article of manufacture, * * * may * * * obtain a patent therefor." (35 U. S. C. 73, R. S. 4929, 4933.)

Statement of the Case.

This is an action for infringement of copyrights 976G and 977G entitled "Sculptured Figure of Female Balinese Dancer" and "Sculptured Figure of Male Balinese Dancer," respectively (R. 19-20). These copyrights were granted upon the basis of specimens submitted to the Copyright Office in the form of statuettes (R. 52a-55). The specimens were simply statuettes, without lamp socket supports, lamp cord holes, or other additional parts required for use of the statuettes in complete lamps (R. 55). The copyrights are in class G, "Works of Art" (R. 19-20).

The statuettes here accused are identical in every artistic respect with the copyrighted statuettes, even to such im-

material detail as size and the author's name worked into the filagree of the female skirt (R. 17-18). The sole differences lie in the functional and inconspicuous additions of (1) a threaded tube protruding from the head to receive a lamp socket and (2) a hole from the base to the tube to receive a lamp cord (R. 10C and 54A). It is not disputed that when the lamp, shade, cord, and other parts are added to make a complete lamp, the statuette remains in full view and that the pleasing artistic concepts of its creator are enjoyed in full by viewers of the copy.

Plaintiffs-Petitioners filed motion for preliminary injunction (R. 6). Defendant-Respondent filed a countermotion to dismiss the case (R. 25). The motion for injunction was denied and the motion to dismiss granted by the District Court (R. 41). The Court of Appeals affirmed (R. 56).

The substance of the opinions below is that, despite complete appropriation of every artistic feature of the original statuettes, the copies here accused are outside the scope of the copyrights because lamp sockets and other parts have been added to form a lamp.

There is some confusion in the opinions below with respect to the specimens submitted to the Copyright Office. The present record shows, and Defendant-Respondent admits, that the specimens were simply statuettes, without protruding stubs to receive lamp sockets or holes for lamp cords (R. 55).

Specification of Errors.

The Court of Appeals erred in reading Section 5 (g) of the Copyright Code as limited by the Design Patent Law, so as to immunize from copyright liability a statuette, sold and used as a lamp base, embodying every element of art in the copyrighted original and copied from the original.

Reasons for Granting the Writ.

1. The decision of the Court of Appeals is irreconcilable with the regulations and practice of the Copyright Office and creates administrative confusion in an important activity of the Copyright Office.

The Copyright Office has adopted a regulation under which "works of artistic craftmanship" are registrable "in so far as their form" is concerned (This Petition, p. 3). Under this regulation the Copyright Office grants registrations to artistic jewelry, fine glassware, sculptured lamp bases, and other works of artistic craftsmanship which meet the statutory requirement of work of art and yet have useful functions.

The decision below holds in substance that a copyrighted statuette is not infringed by a copy intended for use as a lamp base on the theory that the Design Patent Law, not the Copyright Code, controls. If the Design Patent Law controls as to infringement, it also controls as to copyrightability, and the regulation and associated practice of the Copyright Office is wrong. In fact the opinion below is squarely based on the premise that a lamp base is not copyrightable even as to its artistic craftsmanship and hence cannot infringe the copyright to a statuette (R. 57-9).

The Regulation is perfectly clear that "works of artistic craftsmanship" are registrable as to "form but not their mechanical or utilitarian aspects." The

decision below, although quoting the Regulation (R. 58), reaches a wholly conflicting result for it holds that the addition of inconspicuous mechanical and utilitarian features—in no way altering the artistic impression—brings the copy outside the reach of the Copyright Code. The opinion also repeatedly emphasizes that artistic craftsmanship in a lamp base is not copyrightable. The conflict with the Regulation is irreconcilable and can only be resolved by a decision of this Court.

We have attached hereto (pp. 12-14) an exchange of correspondence between counsel for Petitioners and the Copyright Office. The letter of the Register of Copyrights, stating that "The Stein decision has raised a question about the above practice without in fact holding the rule invalid," aptly states the administrative dilemma arising from an opinion quoting from the Regulation while reaching an irreconcilable decision. The letter also makes it perfectly clear that it is the present position of the Copyright Office that the Regulation is correct, although the Office understandably does not commit itself as to the indefinite future.

The Catalogue of Copyright Entries decisively shows the public importance of this problem, both in terms of Copyright Office practice and in terms of the validity and scope of copyrights to works of art. The latest available catalog,* covering the six-month period from January 1950 to June 1950, shows a total of approximately 1000 registrations to statuettes and other three dimensional works of art of which approximately 500 are to artistic perfume bottles (pp. 1, 24); ash trays (pp. 23, 55); dolls and puppets (pp. 1, 18); flower baskets and vases (pp. 4, 17); salt shakers (pp. 4, 16); mugs, jars, etc. (pp. 5, 50); plates and dishes (pp. 5, 15); cemetery memorials (pp. 7, 21); jewelry (pp. 7, 16); lamps (pp. 8, 20); banks (pp. 14, 31); and a host of other artistic but useful objects complying with the Regulation and yet coming squarely within the proscription of the decision below.

* Ten copies filed with this Petition.

This Court has never passed upon Section 5(g) of the Copyright Code, its relation to the Design Patent Law, or upon Regulation 202.8. The time is ripe for a definitive decision, approving or disapproving the practice of the Copyright Office, to guide both the Copyright Office and authors of works of art in connection with their future conduct.

The public interest is never served by unresolved confusion. This Court should pass on this case to dispel the confusion.

2. The decision of the Court of Appeals directly conflicts with the unambiguous language of the Copyright Code.

For over 40 years the Copyright Law has listed "works of art" as one class of copyright subject matter (17 U. S. C. 5(g)). That law also awards the copyright proprietor the "exclusive right" to "copy and vend the copyrighted work" (17 U. S. C. 1(a)). The stautory language is unqualified. There is no statutory exclusion—either as to registration or infringement—with respect to works of art to which have been added elements, such as a lamp socket, to make a device that performs a useful function in addition to displaying the artistic creation.

In fact, while this case involves a lamp base embodiment of the copyrighted work of art, the principle of the decision below wholly denies to copyright owners any recourse against appropriation of their art in paper weights and similar devices which, like the lamp base, appropriate and take value from every artistic feature of the copyrighted statuette. This crippling result was never intended by Congress.

The Court of Appeals rested its opinion on the assertion that the Copyright Code does not "refer to articles of manufacture having a utilitarian purpose" (R. 58). True, but this is wholly irrelevant. The statute does say "works of art" and a work of art is necessarily an article of manufacture and, moreover, necessarily has utility—at least as a paperweight. In

fact, we cannot conceive of a statuette that cannot be made into a lamp by proper choice of size and the addition of socket, bulb, and shade—all without altering the artistic features of the statuette or making them less visible.

The Court was also heavily influenced by its own comparison of the procedural provisions of the Design Patent Law and the Copyright Code. That comparison wholly overlooked the fact that Congress, by the Copyright Code, concluded that the public interest is best served by making works of art copyrightable and unequivocally gave to the owners of all copyrights protection against unauthorized copying in any form. The courts have consistently enforced copyrights against appropriation, no matter how commercial or mundane the appropriation of the artistic concept (*i. e. Bleistein* v. *Donaldson,* 188 U. S. 239 (1903) (circus poster); *King Features* v. *Fleischer,* 299 Fed. 533 (C. A. 2, 1924) (doll reproduction of cartoon character); *Jones Bros.* v. *Underkoffler,* 16 Fed. Supp. 729 (M. D. Pa., 1936) (cemetery memorial)). The Copyright Office has similarly honored this Congressional choice by Regulation 202.8, making works of art copyrightable to the extent of their artistic characteristics regardless of the practical uses of the particular structure in which the art is incorporated.

The Copyright Code requires a work of art and no more. The decision below nullifies that plain language by reading into it the Design Patent Law which nowhere restricts the Copyright Code and is merely complementary to it. That decision is contrary to the first principle of statutory construction; namely, that an unambiguous statute is to be enforced as written. This Court should correct this mistaken construction and dispel the cloud over the existing registrations and those currently being granted by the Copyright Office.

None of the decisions cited by the Court of Appeals or by the District Court in any way supports this rewriting of the Copyright Code.

3. The decision below conflicts with decisions in other circuits, particularly decisions of the Court of Appeals for the Second Circuit. This conflict cannot be resolved without a decision by this Court.

In *Fleischer Studios* v. *Freundlich,* 73 F. (2d) 276 (C. A. 2, 1934), the Court held that a doll reproduction of the cartoon character "Betty Boop" infringed the copyrighted "Betty Boop" cartoons. In that case the copyright proprietor, through a licensee, had distributed thousands of toys and dolls like those accused (73 F. (2d) at p. 277). There was, and could be, no question but that the parties were in competition in selling dolls and that the dolls were articles of manufacture.

The fact of the conflict between the decision below and the *Fleischer* case is brought into sharp focus by the unsuccessful petition for certiorari filed in that case (No. 654, Oct. term 1934). That petition was based solely on the argument that the effect of the *Fleischer* decision was to extend the copyright law to cover subject matter exclusive to design patents. That petition, especially at pages 16 and 17, almost paraphrases the decision of the Court of Appeals in the present case.*

Fleischer v. *Freundlich* followed *King Features* v. *Fleischer,* 299 Fed. 533 (C. A. 2, 1924). The Court there held that a doll reproduction of "Spark Plug" infringed the copyright to the copyrighted "Barney Google" cartoons.

The Court of Appeals for the Second Circuit is not alone in its conflict with the decision below. For example, in *Jones Bros.* v. *Underkoffler,* 16 Fed. Supp. 729 (M. D. Pa., 1936), the Court held that a physical

* We appreciate that denial of certiorari is not necessarily approval of the merits of a case. Yet the denial of two petitions urging opposite sides of the same question cannot help but create confusion, especially as to the Copyright Office which must somehow distill a basis for its own future conduct from these mutually exclusive cases and authors of works of art who must take positive steps to protect their creations.

memorial, intended to hold the body of a deceased person, infringed a class G copyright. The Court, after detailed analysis, squarely rejected the contention that the memorial could only be protected by design patent because it was an article of manufacture and utilitarian in character.

The *Jones* case is one of the decisions relied upon by the Copyright Office in issuing Regulation 202.8 (This Petition, p. 13).

These decisions conflict with the decision below. Under them an "article of manufacture" not only may infringe a copyright but can do so even if the copyright is to a cartoon and the proprietor is in direct competition with the defendant in selling the "article of manufacture." This law cannot be reconciled with the decision in the present case that frees an exact copy from copyright liability because it is embodied in an "article of manufacture".

This conflict of decisions cannot be resolved without a ruling by this Court.

Conclusion.

The regulations and practice of the Copyright Office, the confusion created in the Copyright Office by the decision below, the unambiguous statutory language, and the conflict of circuits join to make this a case where certiorari should be granted in the public interest.

Respectfully submitted,

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Chicago 3, Illinois.

Of Counsel:
C. A. MIKETTA,
W. W. GLENNY.

July 30, 1951.

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BAIR, FREEMAN & MOLINARE

Bair, Freeman & Molinare
1400 Field Building
135 South La Salle Street
Chicago 3, Illinois

Gentlemen:

The three questions asked in your letter of July 17, 1951 are answered as follows:

1. Since the promulgation of Section 202.8 of the copyright regulations (37 C.F.R., Chapter II), it has been the practice of the Copyright Office to register copyright claims to works of art even though they may be adapted for or used as objects of a utilitarian character. The determining factor in such cases is whether the object deposited can in itself be considered a work of art.

This rule was based upon the holding of the courts that there was an overlapping of jurisdiction under the copyright law and design patent legislation, and that the creator of the work possessed an option to elect which type of protection to pursue. (See De Jonge & Co. v. Breuker & Kessler Co., 182 F. 150; In re Blood, 23 F(2d) 772; Jones Bros. Co. v. Underkoffler, 16 F. Supp. 729).

2. The Stein decision has raised a question about the above practice without in fact holding the rule invalid. The Office has not as yet fully considered the effect of this decision upon its future policies.

3. For the fiscal year ending June 30, 1950, 4,013 registrations were made in Class G which encompasses all works of art. Though

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the Office does not maintain a separate record of the number of registrations of claims to copyright in lamp bases and similar objects of possible utility, a perusal of the section of the Catalog of Copyright Entries covering works of art will show that a considerable number of the registrations relate to the types of works to which you have referred.

Sincerely yours,

William P. Siegfried

William P. Siegfried
Acting Register of Copyrights

Office-Supreme Court, U. S.
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SEP 4 1951
CHARLES ELMORE CROPLEY
CLERK

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Petitioners,

vs.

EXPERT LAMP COMPANY, A CORPORATION,
Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO APPLICATION FOR WRIT OF CERTIORARI.

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RESPONDENT'S BRIEF IN OPPOSITION TO APPLICATION FOR WRIT OF CERTIORARI.

Reasons for Denying the Writ.

The Petition attempts to raise questions concerning interpretations of statutes, regulations and practices in the Patent Office and Library of Congress, all of which go counter to the long established practice which followed the case of *Baker* v. *Seldon,* 101 U.S. 99, where

this Court pointed out the distinction between copyrights and patents and held that the **object of a copyright is explanation and the object of a patent is use**; stating (page 105)

> "The object of the one is explanation; the object of the other is use. The former may be secured by copyright. The latter can only be secured, if it can be secured at all, by letters patent."

Since 1842, the Patent Office has, after a thorough examination of the prior art, issued design patents, pursuant to the Patent Act of that date and subsequent patent acts, **on articles of manufacture** which embodied new, original and ornamental designs and which involved invention. Petitioner now contends that the Patent Office examination can be circumvented by going directly to the Library of Congress, under the Copyright Laws, to obtain a 56 year monopoly (original term 28 years with a 28 year renewal). The two Courts below rejected Petitioner's contention that it could by-pass the Patent Office for monopolies on articles of manufacture having mechanical and utilitarian aspects, such as electric table lamps.

The Court of Appeals below, in reaching its decision, relied on the decisions of this Court in *Baker* v. *Seldon, supra,* and *Gorham Co.* v. *White,* 81 U.S. 511. These cases eminently support its decision and have been uniformly followed throughout all of the judicial circuits.

There is no conflict in the decision of the Court of Appeals for the Seventh Circuit with that of any other circuit. Certiorari was denied (321 U.S. 785) in the case of *Taylor Instrument Co.* v. *Fawley-Brost* (C.C.A. 7, 1943) 139 F. (2) 98, which involved the same questions here, namely, the distinction between patent and copyright protection.

Unanimous Decisions by Courts Below.

Both the District Court and the Court of Appeals for the Seventh Circuit (Judges Major, Kerner and Swain) unanimously held that **ornamental designs for electric table lamps** were articles of manufacture for a utilitarian purpose, and may not be monopolized by copyright, but may be protected only by design patent issued by the U. S. Patent Office under 35 U.S.C.A. 73, Sec. 4929, 4933, Revised Statutes.

Question Presented.

May the Patent Office with its rigorous examination, and a possible monopoly of 14 years, be circumvented, and a monopoly obtained for the asking, for a total period of 56 years, on an article of manufacture for a utilitarian purpose, namely, a design of an electric table lamp, through the means of a copyright perfunctorily registered in the Copyright Office?

Statutes Involved.

The Statutes with respect to Design Patents which embrace the instant case are Sections 4929 and 4933 of the Revised Statutes (35 U.S.C.A. 73). They provide that, "Any person who has invented any new, original and ornamental design for an article of manufacture * * * may * * * obtain a patent therefor." They are reprinted in full and discussed in detail on pages 6-10 *infra*.

Sec. 202.8 of the Regulations of the Copyright Office, (37 C.F.R. Chap. II) excludes from its orbit of authority the right to register any articles having mechanical or utilitarian aspects and is reprinted and discussed in

detail on page 10 *infra*. The Copyright Act under which the foregoing regulation is made is reproduced on pages 11-12 *infra*.

Statement of the Case.

Petitioner allegedly copyrighted two statuettes as "works of art", one being a female Balinese dancer and the other being a male Balinese dancer. Petitioner has not manufactured nor sold these figures as statuettes, but has manufactured and sold electric table lamps, complete with electrical sockets, electrical cords, shades, etc. with a figure forming the base of a lamp. Respondent has not manufactured nor sold such statuettes, but has sold only electric table lamps complete with electrical sockets, shades, etc. with a figure forming the base of a lamp.

ARGUMENT.

Procedures and Distinctions Between Obtaining a Copyright and a Design Patent.

The Copyright Office, under the jurisdiction of the Library of Congress, upon the filing of an application for copyright registration and the payment of a $4.00 filing fee, in a matter of several days will perfunctorily issue a certificate of copyright effective for a term of 28 years. This may be perfunctorilly renewed for another like term, making a total monopoly of 56 years. The Copyright Office conducts no examination to determine the existence of originality, novelty or inventiveness in the subject matter. (See *Burrow-Giles Lithographic* v. *Sarony* 111 U.S. 53, 59, pages 9, 10 *infra.*) In effect the Copyright Office acts merely as a recording office, recording everything filed.

The United States Patent Office upon the filing of an application for a design patent including a drawing of the design, a description thereof and claim therefor, conducts a critical examination through all of the pertinent prior art to determine whether the design is new, original, ornamental and **possesses the quality of invention.** If these questions are determined in the affirmative, the Patent Office then may issue a design patent for a term of either 3½, 7 or 14 years, depending upon the fee paid. **Design patents are not renewable** and the designs become public property after the patent expires.

Design Patents Only, Not Copyrights, Protect Designs for Articles of Manufacture.

The design in question being for an electric table lamp may be protected only by means of a design patent and not by a copyright registration. Sections 4929 and 4933 of the Revised Statues (35 U.S.C. 73) dealing with design patents are as follows:

> "Any person who has invented any new, original, and **ornamental design for an article of manufacture,** not known or used by others in this country before his invention thereof and not patented or described in any printed publication in this or any foreign country before his invention thereof, or more than one year prior to his application thereof and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law and other due proceedings had, the same as in cases of inventions or discoveries covered by Section 31 of this title, **obtain a patent therefor.**"
>
> "All the regulations and provisions which apply to obtaining or protecting patents for inventions or discoveries not inconsistent with the provision of this title, shall apply to patents for designs. (R.S. Secs. 4929, 4933; May 9, 1902, ch. 783, 32 Stat. 193; Aug. 5, 1939, ch. 450, sec. 1, 53 Stat. 1212.)" (Emphasis supplied)

The Supreme Court in the leading case of *Gorham* v. *White*, 81 U.S. 511, 524, stated:

> "It is a **new and original design for a manufacture,** whether of metal or other material, **a new and original design for a bust, statute,** bas relief, or composition in alto or basso relieva; a **new or original impression or ornament to be placed on any article of manufacture** * * * or **a new or original shape or configuration**

> **of any article of manufacture**—it is one or all of these that the law has in view. And the thing invented or produced, for which **a patent is given,** is that which gives a peculiar or distinctive appearance to the manufacture, or article to which it may be applied, or to which it gives form." (Emphasis supplied)
>
> See also *Smith* v. *Whitman,* 148 U.S. 674.

The *Gorham* case is still the leading authority on this subject and has never been overruled nor superseded and is constantly relied upon by the Courts in current opinions.

The section of the Patent Laws dealing with infringement of design patents provides in part as follows:

35 U.S.C.A. Sec. 75:

> "During the term of **letters patent for a design,** it shall be unlawful for any person other than the owner of said letters patent, without a license of such owner, **to apply the design** secured by such letters patent, or any colorable imitation thereof, **to any article of manufacture** for the purpose of sale, or to sell or expose for sale any **article of manufacture** to which such design or colorable imitation shall, without the license of the owner, have been applied, knowing that the same has been so applied." (Emphasis supplied)

The United States Patent Office, since the first design patent act in 1842, has granted **design patents on articles of manufacture.** To illustrate this long standing practice, a few representative design patents issued by the Patent Office are contained in the Record page 28 to 40 inclusive. Various bases and designs for table lamps are shown therein.

The Courts, throughout the country and in the various circuits, have long recognized that design patents are

the media by which articles of manufacture may be protected, and, in passing on the validity of a design patent, have uniformly applied the test of patentability, namely, in order for a design patent to be valid, in addition to being new and ornamental, it must involve invention. A few representative cases are herewith cited:

First Circuit

National Automatic v. *Automatic Machinery,* 111 F. 401

Illinois Watch Case v. *Hingeco Mfg. Co.,* 81 F. (2) 41

Second Circuit

Neufeld-Furst & Co. v. *Jay-Day Frocks,* 112 F. (2) 715

Gold Seal Importers v. *Morris-White,* 124 F. (2) 141

Third Circuit

Phoenix Knitting v. *Hygienic,* 194 F. 696

Rose Mfg. Co. v. *Whitehouse,* 208 F. 564

Fourth Circuit

Robertson, Com. of Patents v. *Cooper,* 46 F. (2) 766

Connecticut Paper v. *N. Y. Paper,* 127 F. (2) 423

Sixth Circuit

Western Auto Supply Co. v. *American National Co.,* 114 F. (2) 711

CAVU Clothes v. *Squires,* 184 F. (2) 30

Seventh Circuit

Heuter v. *Compco,* 179 F. (2) 416

Associated v. *Gits,* 182 F. (2) 1000

Eighth Circuit

King Ventilating Co. v. *St. James Ventilating*, 26 F. (2) 357

Ninth Circuit

Magarian v. *Detroit Products*, 128 F. (2) 544

Faris v. *Patsy Frock*, 273 F. 900

There is no conflict between the decisions of any of the Circuit Courts of Appeal that designs for articles of manufacture *may* be protected only by *design patents* under the PATENT LAWS, and that in order to sustain validity of a design patent, *invention* must be involved.

In this case, Petitioner alleges that any one can obtain for himself a monopoly merely by ignoring the Patent Office and doing business with the Copyright Office of the Library of Congress. Petitioner provides self-serving evidence of monopolies on designs for electric table lamps, as well as for other products such as toy banks, jewelry, cemetery memorials, plates and dishes, salt shakers, dolls, jars, etc. Petitioner is setting up the Copyright Office as a cut-rate competitor of the Patent Office.

This Court, in *Burrow-Giles Lithographic* v. *Sarony*, 111 U.S. 53, pointed out that there is a distinction between the issuance of a patent and a copyright, stating: p. 59:

> "In regard, however, to the kindred subject of patents for invention, they cannot by law be issued to the inventor until the novelty, the utility, and the actual discovery or invention by the claimant have been established by proof before the Commissioner of Patents; and when he has secured such a patent, and undertakes to obtain redress for a violation of his right in a court of law, the question of invention,

> of novelty, of originality, is always open to examination. Our copyright system has no such provisions for previous examination by a proper tribunal as to the **originality of the book, map or other matters offered for copyright.** A deposit of two copies of the article or work with the Librarian of Congress with the name of the author and its title page, is all that is necessary to secure a copyright." (Emphasis supplied)

"Works of Art" Under the Copyright Law Do Not Apply to Articles of Manufacture Having Mechanical and Utilitarian Aspects, Such As Electric Table Lamps.

Petitioner's alleged copyrights granted by the Library of Congress, do not give it a monopoly to enjoin the manufacture, use and sale of electric table lamps.

Petitioner's brief, page 3, quotes Regulation, Sec. 202.8 of the Copyright Office which reads as follows:

> "Sec. 202.8 Works of Art (Class G)—(a) In general. This class includes works of artistic craftsmanship, insofar as their form but **not their mechanical or utilitarian aspects are concerned,** such as artistic jewelry, enamels, glassware, and tapestries, as well as all works belonging to the fine arts, such as paintings, drawings and sculpture. * * *" 17 U.S.C. foll. sec. 207 (Emphasis supplied)

The very wording of the above regulation which was promulgated by the Copyright Office itself, indicates clearly that the Copyright Office excludes from its orbit of authority any right to grant monopolies on articles which have **mechanical or utilitarian aspects,** such as the electric table lamps here under consideration.

Both Courts below found no difficulty in interpreting this regulation. In fact, the Court of Appeals below quotes this regulation in its opinion (R. 58). No court in any other circuit has interpreted it otherwise. It has

always been the practice to protect articles of manufacture having mechanical and utilitarian aspects and possessing a new, original and ornamental design of inventive character, only by design patents and not by copyrights.

That the copyright laws are intended to protect those things which are printed and published for information and not for use in themselves, is clear, and dates back to the passage of the first COPYRIGHT ACT of May, 1790, which was entitled:

> "An act for the encouragement *of learning* by securing the copies of *maps, charts* and *books* to the Authors, to the Proprietors of such copies, during the time therein mentioned." (Emphasis supplied)

The first section of this act dealt with authors or proprietors of books and used the following language:

> "Any other person being a citizen of the United States who had purchased or legally acquired the copyright of such book, in order to **print, reprint, publish** or **vend** the same, shall have the sole right and liberty of printing, reprinting, publishing and vending the same." (Emphasis supplied)

The above emphasized words are contained in Title 17, Sec. I of the present COPYRIGHT ACT.

From the nature of the rights granted by the present COPYRIGHT LAW, it is clear that the law does not contemplate covering an article of manufacture having a utilitarian purpose.

Title 17, Sec. 1 of the present COPYRIGHT LAW provides that a copyright owner shall have the exclusive rights to

> (a) "To *print, reprint, publish, copy* and *vend* the copyrighted work,"

(b) "To translate the copyrighted work into other languages," etc.

(c) "To deliver or authorize the delivery of the copyrighted work in public for profit, if it be a lecture, sermon, address or similar production."

(d) "To perform or represent the copyrighted work publicly, if it be a drama, or," etc.

(e) "To perform the copyrighted work publicly for profit, if it be a musical composition;" etc.

Section 10 of the present COPYRIGHT ACT provides:

"**Publication** of Work with Notice.—Any person entitled thereto by this title may secure copyright for his work by **publication** thereof with the notice of copyright."

Section 13 of the present COPYRIGHT ACT provides:

"Deposit of Copies After *Publication*, Action or Proceeding For Infringement.—After copyright has been secured by *publication* * * * there shall be promptly deposited in the Copyright Office or in the mail addressed to the Register of Copyrights, Washington, District of Columbia, two complete copies of the *best edition* thereof then *published, or if the work is by an author* who is a citizen or subject of a foreign state or nation", etc. (Emphasis supplied)

From the foregoing provisions of the present COPYRIGHT LAW it is clearly evident that nowhere are words used which would be applicable to an article of manufacture having a utilitarian purpose, such as an electric table lamp. The words **print, reprint, publish, copy** and **vend** in Sec. 1; the word **publication** in Sec. 10, and the words **publication, best edition, published, author,** in Section 13, are words clear in their intent and meaning

and are in conformity with the words contained in the Constitutional provision* which were intended to relate to copyrights, namely, *"Authors"* and *"Writings"*.

The words *print, reprint, publish* or *vend* are the same words used in the first copyright act of 1790, which was entitled, "An Act for the encouragement of *learning* by securing the copies of maps, charts and books to the *Authors,* to *Proprietors* of such copies." (Emphasis supplied throughout.)

Obviously, an electric table lamp can not be "printed" or "published". It cannot be a "publication" and is not created by an "author", nor can "editions" be filed.

The Supreme Court in the TRADE MARK cases, 100 U.S. 82, stated:

> "And while the writings may be liberally construed, as it has been, to include original designs for engraving, prints, etc., it is only such as are original, and are founded in the creative powers of the mind. The *writings* which are to be protected are the fruits of intellectual labor, embodied in the form of *books, prints, engravings and the like."* (Emphasis supplied.)

The Supreme Court in *Baker* v. *Seldon,* 101 U.S. 99, pointed out the distinction between copyrights and pat-

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* Constitutional provision governing patents and copyrights, Article I, Sec. 8, Clause 8, "to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

The historical background leading to the adoption of this provision of the Constitution makes it clear that the words 'science', 'authors' and 'writings' are related in the context and the words 'useful arts', 'inventors' and 'discoveries' are similarly related in the context. See also Burrow-Giles v. Sarony, 111 U.S. 53, infra p. 14.

ents and held that the *object of a copyright is explanation and the object of a patent is use.*

The Court stated:

> (p. 102)—"A treatise on the composition and use of medicines, be they old or new, on the construction and use of ploughs, or watches, or churns; or on the mixture and application of colors for painting or dyeing; or on the mode of drawing lines to produce the effect of perspective, would be the subject of copyright; *but no one would contend that the copyright of the treatise would give the exclusive right to the art or manufacture described therein.* • • •
>
> To give the author of the book an exclusive property in the art described therein, when no examination of its novelty has ever been officially made, would be a surprise and a fraud upon the public. That is the province of letters patent, not of copyright. *The claim to an invention or discovery of an art or manufacture must be subjected to the examination of the Patent Office before an exclusive right therein can be obtained; and it can only be secured by a patent from the government.*
>
> • • •
>
> (p. 105)—The description of the art in a book, though entitled to the benefit of a copyright lays no foundation for an exclusive claim to an art itself. *The object of the one is explanation; the object of the other is use. The former may be secured by copyright. The latter can only be secured, if it can be secured at all, by letters patent.*" (Emphasis supplied.)

The Supreme Court in *Burrow-Giles* v. *Sarony,* 111 U.S. 53, a case dealing with the question as to whether a photograph was subject to copyright, considered the interpretation of the words "authors" and "writings" in the Constitution in their relation to the copyright laws and stated:

(p. 56)—"The eighth section of the first Article of the Constitution is the great repository of the powers of Congress, and by the eighth clause of that section Congress is authorized:

> 'To promote the progress of science and useful arts, by securing, for limited times to *authors* and inventors the exclusive right to *their respective writings* and discoveries.'

"The argument here is, that a photograph is not a writing nor the production of an author. Under the acts of Congress, designed to give effect to this section, the persons who are to be benefited are divided into **two classes, authors and inventors.** The monopoly which is granted to the **former** is called a **copyright,** that given to the **latter, letters patent,** or, in the familar language of the present day, patent right.

* * *

> 'According to the practice of legislation in England and America' says Judge Bouvier, 2 Law Dictionary, 363, **'the copyright is confined to the exclusive right secured to the author or proprietor of a writing or drawing which may be multiplied by the arts of printing in any of its branches.'**

(p. 58)—"By writings in that clause is meant the literary productions of those authors, and Congress very properly has declared these to include all forms of writings, printing, engraving, etching, etc., by which the ideas in the mind of the author are given visible expression." (Emphasis supplied.)

The Supreme Court in *Perris* v. *Hexamer,* 99 U.S. 674, stated:

> (p. 675)—"A copyright gives the author or the publisher the exclusive right of multiplying copies of what he has written or printed."

The decisions of this Court are clear on what may comprise the subject matter of a copyright. Clearly such sub-

ject matter does not embrace a design for electric table lamps which design may be protected, if at all, only by design patents. The regulation of the copyright office hereinbefore quoted makes this clear.

The Court of Appeals for the Seventh Circuit (Judges Minton, Major and Lindley) in *Taylor Instrument Co.* v. *Fawley-Brost Co.,* (1943) 138 F. (2d) 98, in reviewing the distinctions between copyrights and patents held that **an object of use is subject to patent protections and not to copyright protection,** that there can be **no overlapping between copyrights** and **patents,** and that protection must be found in one or the other, it cannot be found in both. Certiorari was denied in 321 U.S. 785.

The instant case which decided the same question is merely a reaffirmation of the *Taylor* case.

H. A. Howell, formerly Assistant Register of Copyrights, a recognized authority on copyright practice, in his book entitled, "The Copyright Law" published in 1948, classifies what may be copyrighted and what may be the subject of a design patent. His classification would place an electrical table lamp under the applied arts which may be protected only through the medium of a design patent. He states:

> (p. 20)—"Works of art may for the most practical purposes be divided into four classes" (see *United States* v. *Perry,* 146 U.S. 71 (1892)
>
> • • •
>
> "(4) Objects primarily designed for a useful purpose, but made ornamental to please the eye and gratify the taste, such as ornamental clocks, curtains, rugs, gas fixtures, household furniture, etc., commonly called applied art."

"Not all of these classes, however, would come within the scope of the existing copyright law. **Congress has provided otherwise for No. (4)** in Section 4929 of the Revised Statutes to the effect that 'any person who has invented any new, original and ornamental design for an article of manufacture'' may on certain conditions **obtain a patent therefor;** and hence the registration of such a design would come within the jurisdiction of the **Patent Office** whenever the **finished product is an article of utility, however artistic in appearance it may be.**'' (Emphasis supplied)

Cases Cited by Petitioner.

Petitioner attempts to make it appear that the decision below conflicts with the decisions of the Court of Appeals for the Second Circuit in *Fleischer Studio* v. *Freundlich* (1934) 73 F. (2) 276, and *King Feature Syndicate* v. *Fleischer,* (1924) 299 F. 533. As will be seen by reference to the decisions of the Court of Appeals for the Second Circuit on p. 8, *supra,* the Court there held that designs for articles of manufacture may be protected by design patents and that such designs must involve invention.

In the *Fleischer* case relied upon by Petitioner, the plaintiff there had created a new cartoon character known as "Betty Boop." This character had been exhibited in motion picture cartoons and had become very popular and widely known, In addition, Plaintiff's licensee had sold large quantities of "Betty Boop" dolls. The Court there said:

> (p. 278)—"What the appellant constructed is recognizable by an ordinary observor as having been taken from the copyrighted source. Such is infringement."

In the *King Feature* case, the plaintiff had created cartoon characters known as "Barney Google", and "Spark Plug" or "Sparky", a horse. The plaintiff had published his cartoons and had syndicated them to newspapers throughout the country with wide circulation, running into millions, where they appeared daily as comic strips. Defendants manufactured a toy horse which was copied after plaintiff's cartoon character, "Spark Plug" and, in addition, labeled it and sold it as "Spark Plug" and "Sparky." The Court held that this was an infringement of plaintiff's rights.

Neither of these cases is pertinent to the question presented here, nor can the facts therein be compared to the present case.

Petitioner was not the first to create Balinese figures and those here in issue can in no way be said to be unique. The use of male and female Balinese dancing figures for decorative purpose has been common for many years, as will be seen by reference to the Record, pages 46-50.

Petitioner's Balinese figures here in issue have not been publicized nor sold in any great quantity, such as to make them "recognizable by an ordinary observor as having been taken from the copyrighted source."

Petitioner would like to leave the impression that these two cases decide something other than what was actually decided. We believe that a later decision of the District Court of New York very clearly and succinctly points out, what these cases truly determine. The Court in *Adelman, Inc.* v. *Sonner's & Gordon,* 21 U.S.P.Q. 218, stated:

(p. 219)—"The plaintiff urges that *King Feature Syndicate* v. *Fleischer et al.* (299 Fed., 533, C.C.A. 2) supports its contention. In fact, this case is its chief reliance. In that case the plaintiff was the owner of a copyrighted picture consisting of cartoons and comic sketches depicting a horse—'Spark Plug'—and a male character, 'Barney Google', in a variety of ludicrous situations. The defendant manufactured and sold a grotesque figure and toy exactly reproducing 'Spark Plug.' The court held that the defendant infringed the plaintiff's copyright. *These articles were entirely lacking in any functional use; they served no utilitarian purpose; their form was the essence of the article, and the court pointed out that the toy horse 'Spark Plug' was nothing more than a glorified cartoon.*"

* * *

"*King* v. *Fleischer* does not depart from the rule of *Baker* v. *Seldon, supra.* On the contrary, it cites and recognizes the rule in *Baker* v. *Selden.* As I read it, it merely holds that in this particular instance the reproduction of the defendant's was essentially a copy of plaintiff's cartoon or comic sketch. *It certainly could not even be inferred from King* v. *Fleischer that if a person copyrighted a design for a 'stream line' automobile the copyright owner would have the exclusive right to produce such an automobile, or that the copyright owner of a drawing of a dress would have the exclusive right to produce the dress. It merely applied the old rule, but perhaps to an unusual set of facts.*" (Emphasis supplied.)

Subsequent to the above decisions of the Court of Appeals in the Second Circuit, in the *King Feature* and *Fleischer* cases, the same Court in *Jackson* v. *Quickslip Co.,* 110 F. (2) 731 (C.C.A. 2, 1940) held that toys are not copyrightable. The Court stated, page 732:

> "*There is no copyright for toys,* badges, or similar apparatus alone or fastened to a book. Rule 12, Copyright Rules 17 U.S.C.A. following Section 53, *Royal Sales* v. *Gaynor,* 164 F. 207; *Hollinrake* v. *Truswell* (1894) 3 Ch. 420."

Any conflict in decisions which petitioner attempts to show disappears into thin air when the cases are studied.

In *Jones Bros. Co.* v. *Underkoffler,* 16 F.S. 729 (M.D. Pa., 1936) the District Court held that a copyright of a design for a cemetery monument was infringed by the physical monument. The decision in this case was not presented to an appellate tribunal for review.

In re Blood, 23 F. (2d) 772, (App. D.C. 1927) the copyright in question involved an ornamental design for a printed hosiery ticket.

In *DeJonge & Co.* v. *Breuker & Kessler Co.,* 182 F. (2) 150 (C.C.E.D. Pa.; 1910) the copyright involved a painting and its printed reproductions.

In *Bleistein* v. *Donaldson,* 188 U.S. 239 (1903), the Plaintiffs had copyrighted three chromolithographs or pictorial illustrations used in advertisements for a circus. The Supreme Court held that circus advertisements are within the protection of the Copyright Laws. Clearly this case supports Respondent's position that the Copyright Laws protect only printed matter in whatever form produced and not articles of manufacture, such as electric table lamps which have utilitarian and mechanical aspects.

CONCLUSION.

The Patent (design) and Copyright Laws and practice thereunder are clear. Congress never intended to nullify the possible monopoly of 14 years on designs from the Patent Office with an unquestioned monopoly for the mere asking, running for 56 years. The Courts have never sanctioned such a legal short circuit.

If Petitioner is right, then the Patent Office may as well close up its design division. Why should any one go there to face a possible refusal when he can get positive action in his favor from the Copyright Office? If the two are in competition, as Petitioner alleges, then why should not every one go to the Copyright Office? He gets more with less trouble and at a lower cost.

It is respectfully submitted that the concurrent decisions of the Courts below are correct, and that this case does not merit review by this Court. Certiorari should be denied.

Respectfully submitted,

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August 31, 1951.

FILED
SEP 10 1951
CHARLES ELMORE CROPLEY
CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1951.

No. 217

BENJAMIN STEIN, RENA STEIN AND HENRY KUTNER, DOING BUSINESS AS REGLOR OF CALIFORNIA,

Petitioners,

vs.

EXPERT LAMP COMPANY, a CORPORATION,

Respondent.

PETITIONERS' REPLY BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

WILL FREEMAN,
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Of Counsel:
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September 6, 1951.

THE BLAKELY PRINTING COMPANY, 810 WEST JACKSON, CHICAGO

IN THE

Supreme Court of the United States

OCTOBER TERM, 1951.

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Respondent.

PETITIONERS' REPLY BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

Respondent states:

> "There is no conflict between the decisions of any of the Circuit Courts of Appeal that designs for articles of manufacture *may* be protected only by *design patents* under the PATENT LAWS, * * *." (p. 9.)

The fact is that the Court of Appeals for the Second Circuit has twice held copyrights to be infringed by articles of manufacture (*Fleischer Studios* v. *Freundlich,* 73 F. (2d) 276 (1934) ("Betty Boop" cartoon character reproduced by defendant as a doll—plaintiff also manufactured dolls through licensee); *King Features* v. *Fleischer,* 299 Fed. 533 (1924) ("Spark Plug" cartoon character reproduced as a doll)). Also, in *Jones Bros.* v. *Underkoffler,* 16 Fed. Supp. 729 (M. D. Pa., 1936), the court, after detailed analysis, concluded that a work of art in the form of a cemetery memorial is copyrightable.

The Copyright Office considers that the Copyright Code and decisions support the copyrightability of a work of art, even though it may be embodied in a lamp or other object of use (Petition, p. 13). By Regulation 202.8 (Petition, p. 3) that Office has extended an invitation to creators of such works of art to procure copyright registration. Each year hundreds of such copyrights, solemnly issued under the seal of the Copyright Office, are granted and relied upon (Petition, p. 6).

The decision below is in irreconcilable conflict with the above decisions and the practice of the Copyright Office. The conflict can be dispelled only by a decision of this Court. It cannot be resolved by refusal to face its existence (Brief, p. 9); misreading the Copyright Regulation (Brief, p. 10); importing non-existent mandatory language into the Design Patent Law and decisions (Brief, pp. 6-8); or by mechanically listing the respective characteristics of copyrights and design patents (Brief, pp. 5, 11-17).

The important point is that the Copyright Office and the prior decisions, on one hand, and the decision below, on the other hand, cannot both be right. The validity and scope of these hundreds of copyrights already issued, and the hundreds to be granted in the future, turns on the resolution of this conflict.

Confusion is never in the public interest. Certiorari should be granted.

Respectfully submitted,

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